

## **REMARKS**

The Office Action dated June 4, 2003, has been received and carefully considered. In this response, claims 1-40 have been amended. In addition, claims 41-43 have been added to more fully defined the scope of the Applicants' invention. Reconsideration of the outstanding rejections in the present application is also respectfully requested based on the following remarks.

### **I. THE OBVIOUSNESS REJECTION OF CLAIMS 1-3, 5-10, and 12-22**

At paragraph 3 of the Office Action, claims 1-3, 5-10, and 12-22 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application No. 2001/0032245 to Fodor in view of U.S. Patent Application No. 2002/0099681 to Gainey et al. This rejection is hereby respectfully traversed.

#### **A. Basic Requirement for Prima Facie Case of Obviousness**

As stated in MPEP § 2143, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Also, as stated in MPEP § 2143.01, obviousness can only be established by combining or modifying the teachings

of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Further, as stated in MPEP § 2143.01, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). That is, “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970). Additionally, as stated in MPEP § 2141.02, a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). Finally, if an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

**B. The Examiner’s Argument for Obviousness with Respect to Claims 1, 7 and 20**

With respect to Claim 1, the Examiner states that:

Fodor discloses a document delivery system which includes a document system for producing document data, a system for determining whether a requested document is designated for electronic delivery or non-electronic delivery based on a stored document delivery designation (page 1, section 0009-0010), and a failed email management system which is configured to receive a notice of a failed email delivery and to change a document delivery designation for at least the intended recipient of the failed email.

Office Action, pg. 2, ¶1.

With respect to Claim 7, the Examiner similarly states that:

Fodor discloses a system for monitoring the electronic delivery of documents, said system comprising a document system for producing document information, said document system a system (abstract); wherein said system management system determined whether a requested document is designated for electronic delivery or non-electronic delivery; . . . a failed email management system (fig. 2, unit 110, 142), wherein the system is configured to receive documents designated for non-electronic (fig. 2, unit 102); . . . wherein said failed email management system is configured to receive a notice of a failed email delivery including a failed email address (page 3-4, section 0033), and to change a document delivery designation for at least the intended recipient of the failed email; (page 3-4, section 0033)

(Office Action, pg. 3, ¶2).

With respect to Claim 20, the Examiner again similarly states that:

Fodor discloses a method for electronically delivering documents, said method comprising the steps of producing document data; accepting requests to send selected documents (abstract); determining whether a selected document is accepted for electronic delivery or non-electronic delivery (fig. 2, unit 114, 110); . . . storing documents and document data for documents accepted for electronic delivery (page 1, sections 0009-0010); providing Internet access to the documents and document data accepted for electronic delivery (fig. 1); providing notice regarding the status and availability of said stored documents and document data to intended document recipients (page 2-3, section 0024); detecting the failed delivery of notices to intended notice recipients (page 3-4, section 0033).

(Office Action, pg. 4 ¶1).

For each of these claims, however, the Examiner admits that Fodor does not disclose either “a print management system” or system for the “non-electronically delivery” of documents. (Office Action, pg. 5, ¶2). The Examiner, however, cites Gainey for teaching each of the these elements and concludes:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teaching of Fodor to have the use of a print management system taught by Gainey in order to send a recipients a hardcopy of the system response (page 1, section 0006).

(Office Action, pg. 5 ¶2).

**C. Applicants' Argument Regarding claims 1, 7 and 20.**

Respectfully, the Examiner has failed to show how Fodor teaches or suggest the steps of the Applicants' invention for which it is cited. Further, the Examiner has failed to show how Gainey teaches or suggest the steps of the Applicants' invention for which it is cited. Additionally, the Examiner has failed to identify a specific teaching or suggestion to make the claimed combination.

**1. Fodor Fails to Teach or Suggest The Steps For Which It is Cited.**

The Applicants' respectfully submit that Fodor fails to teach or suggest the specific steps for which it is cited. More specifically, in contrast to the Applicants' invention, Fodor is method and system fail to teach or suggest a document processing system which includes any of the following steps or mechanisms:

- a print management system for determining whether a requested document is designated for electronic delivery or non-electronic delivery based on a stored document delivery designation, or
- a failed email management system which is configured to receive a notice of a failed email delivery and to change a document delivery designation for at least the intended recipient of the failed email.

Fodor as a reference is limited strictly to an email processing system which organizes and forwards email. One element of Fodor cited by the Examiner includes a mechanism for sending

an error message when a bad email address is identified. However, this mechanism is taught by Fodor as strictly as follows:

[0023] If, at step **104**, the message received is identified as having a recognized recipient domain, the second step is to then route, at step **114**, to the server (SMTP listener) associated with the MX record in question. If the specified domain was not recognized, the DNS will respond at step **110** with an error message “no valid recipient on specified domain”. These SMTP listeners will be configured to receive traffic on a preferred port, thereby blocking all other unrelated traffic.

(Fodor Patent, Page 2).

Additionally, as further pointed out by the Examiner, Fodor also includes a mechanism for verifying the identity of an email user prior to allowing them access to a mailbox. However, as also cited by the Examiner, this mechanism is taught by Fodor as strictly as follows:

[0033] A check may be performed at step **230** to verify that the client **10** exists by checking the local mailbox database **14** to determine whether the client **10** connection references a valid email account. While this client information retrieval step would not necessarily refer the request to a particular email server, it would contain the verification information that authorizes the client to continue with the retrieval. If the client is not found, an error message can be generated and logged at step **232**.

(Fodor Patent, Page 3).

Accordingly, in contrast to the Applicants' invention, Fodor's method for processing email completely fails to teach or suggest a document processing system which includes either:

- a print management system for determining whether a requested document is designated for electronic delivery or non-electronic delivery based on a stored document delivery designation, or
- a failed email management system which is configured to receive a notice of a failed email delivery and to change a document delivery designation for at least the intended recipient of the failed email.

Accordingly, for this reason alone, it is respectfully submitted that the aforementioned obviousness rejections of claims 1, 7, and 20 are improper, and the withdrawal of such rejection is respectfully requested.

**2. In Addition to the Failure of Fodor, Gainey Also Fails to Teach or Suggest The Steps For Which It is Cited.**

As with Fodor, Gainey is cited by the Examiner as teaching and disclosing the non-electronic delivery of documents. However, Gainey fails in anyway to teach or suggest any method for delivering non-electronic documents.

Specifically, in contrast to the Applicant's invention, Gainey strictly teaches an enterprise email management system which is designed to handle large volumes of electronic documents. A key aspect of Gainey's system is a method for sorting and organizing emails for retrieval by email users. As cited by the Examiner, Gainey summarizes his system as follows:

(0006) Enterprise email system users subscribe to variable mail queues. When an enterprise email system user logs into the system, the enterprise email system delivers a set of messages from the mail queues that the user subscribes to into the enterprise email system user's mailbox. The user responds to the messages. To aid the user, the enterprise email system may create a template response message including a proposed message body, a set of attachments, and a set of recipients that should receive a copy of the response message.

...

(0054) When a category is assigned to a message, the incoming email receiver 120 refers to a category database 135. The category database 135 is conceptually similar to a Frequency Asked Questions (FAQ) file for an organization. Specifically, each category entry in the category database 135 addresses a common problem, question, or request. For example, a software company supporting a word processing program may have category entries for "Word processor software installation", "Opening Documents", "Editing Documents", and "Printing Documents".

(0055) The category database 135 is organized in a hierarchical form wherein each category may have several subcategories. For example, the "Printing Documents" category entry may have

subcategory entries for “Printing Documents using a printer coupled directly to the personal computer” and “Printing Documents using a printer coupled to a network.” Each subcategory may have additional subcategories.

Accordingly, Gainey teaches only a method for handling electronic documents. More specifically, as with Fodor, Gainey’s method and system fail to teach or suggest a document processing system which includes either:

- a print management system for determining whether a requested document is designated for electronic delivery or non-electronic delivery based on a stored document delivery designation, or
- a failed email management system which is configured to receive a notice of a failed email delivery and to change a document delivery designation for at least the intended recipient of the failed email.

Therefore, for these reasons alone, it is respectfully submitted that the aforementioned obviousness rejections of claims 1, 7, and 20 are improper, and the withdrawal of such rejection is respectfully requested.

**3. Beyond the Failure of Fodor and Gainey To Teach or Suggest the Applicant’s Invention, The Examiner has Failed to Establish a Prima Facie Case of Obviousness For Combining the References.**

The Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness in the Examiner’s their argument for combining Fodor and Gainey. The Examiner admits that Fodor fails to disclose “a print management system” or “non-electronically delivery” but the Examiner fails to provide a prior-art reference that teaches, suggests or motivates the use of this step in combination with the additional claimed elements of the Applicants’ invention. Instead, the Examiner has argued the combination of Fodor and Gainey based solely on the Examiner’s reasoning that:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teaching of Fodor to have the use of a print management system taught by Gainey in order to send a recipients a hardcopy of the system response (page 1, section 0006).

(Office Action, pg. 5 ¶2).

Any suggestion to suggestion to combine must be found either **explicitly or implicitly** in the references themselves. MPEP § 2143.01. Absent a specific showing by the Examiner of prior art indicating otherwise, the Applicants submit that the combination of steps claimed in claims 1, 7, and 20 were not within the knowledge generally available to one of ordinary skill. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

### **3. Conclusions Regarding claims 1, 7 and 20.**

Respectfully, the Examiner has failed to show how either Fodor or Gainey teach or suggest the steps of the Applicant's invention for which they are cited. Further, the Examiner has failed to identified a specific teaching or suggestion for combining the teachings of Fodor and Gainey.

In view of the foregoing, it is respectfully submitted that the aforementioned obviousness rejection of claims 1, 7 and 20 are improper, and the withdrawal of such rejection is respectfully requested. Further, as claims 2-6, 8-19, and 21-40 are dependent on claims 1, 7 and 20 respectively, and these claims should also be found allowable over the prior art for the reasons cited above. Similarly, newly added claims 41-43 should also be found allowable over the prior art for the reason cited above.



### III. CONCLUSION

In view of the foregoing, it is respectfully submitted that the present application is in condition for allowance, and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed telephone number, in order to expedite resolution of any issues and to expedite passage of the present application to issue, if any comments, questions, or suggestions arise in connection with the present application.

To the extent necessary, a petition for an extension of time under 37 CFR § 1.136 is hereby made.

Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-0206, and please credit any excess fees to the same deposit account.

Respectfully submitted,

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